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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,456	01/28/2002	Gordon R. Wren	PHN01-001	4151
7590 11/29/2005				
Gordon R. Wren Phun From Phoenix !, Inc. P.O. Box 25583 Tempe, AZ 85285-5583		EXAMINER AMERSON, LORI BAKER		
		ART UNIT PAPER NUMBER		
		3764		

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,456

Applicant(s)

WREN, GORDON R.

Examiner

L. Amerson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-17 is/are allowed.
- 6) ☒ Claim(s) 1-6, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Valasek. Valasek discloses all of the limitations of the instant invention.

Regarding the language "formed to co-operate with marking instruments for forming a design on the area and for removing the design from the area", "suitable for drawing a face on the head section", "wherein the torso section is wider than either the head section or the neck section", "shape suitable for returning the therapeutic device to an upright position when deflected from an upright position", has not been given patentable weight because the recitation is purely functional in nature and does not recite any structure.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

b. Claims 1-5, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Barnes and Kwan. Spector discloses a bop-bag (10, col. 3, line 51) having a humanoid shape (fig.1) and a cover (col. 3, lines 48-50) and an area (10) devoid of printing. Regarding the language "formed to co-operate with marking instruments for forming a design on the area and for removing the design from the area" has not been given patentable weight because the recitation is purely functional in nature and does not recite any structure. Spector discloses all of the limitations of the claimed invention except for the bag being devoid of an inflation stem projecting through a slit in a top area of the resilient outer cover and a humanoid shape. Thus, Barnes teaches a device having a humanoid shape and Kwan teaches a device devoid of an inflation stem projecting through a slit in a top area of the cover. It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a bag devoid of an inflation stem projecting through a slit in a top area of the cover in order to conceal the location of the stem. Regarding the shape, a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Regarding the material, the Applicant should note that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 967, 125 USPQ 416 (CCPA 1960). As to claim 2, the area includes a head section (F). Regarding the

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language "suitable for drawing a face on the head section" has not been given patentable weight because the recitation is purely functional in nature and does not recite any structure. As to claim 3, further including a neck section and torso section (fig. 1). Regarding the language "wherein the torso section is wider than either the head section or the neck section" has not been given patentable weight because the recitation is purely functional in nature and does not recite any structure. As to claim 4, the head section (fig. 3 - rear of bag) having the area. As to claim 5, including a base section having a weight (13). Regarding the language "shape suitable for returning the therapeutic deceive to an upright position when deflected from an upright position" has not been given patentable weight because the recitation is purely functional in nature and does not recite any structure.

c. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spector, Barnes and Kwan and further in view of Wilkinson. The references disclose all of the limitations of the claimed invention but is silent as to the material selection. Wilkinson teaches a bag made from PVC. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Spector in view of the teaching of Wilkinson such that a bag made from PVC is durable for striking.

Allowable Subject Matter

4. Claims 7-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Amerson whose telephone number is (571) 272-4971. The examiner can normally be reached on Mon.-Fri from 9-6 p.m. Interviews Tue. and Thur..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Amerson